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09/882,165	06/15/2001	Joseph A. Manico	82117F-P	9385

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EXAMINER

DIVINE, LUCAS

ART UNIT	PAPER NUMBER
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2624

DATE MAILED: 02/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/882,165	Applicant(s) MANICO ET AL	
	Examiner Lucas Divine	Art Unit 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 7-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 7-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/26/06 has been entered.

Response to Amendment

2. Claims 1-4 and 7-20 are pending.

Response to Arguments

3. Applicant's arguments filed 1/26/06 have been fully considered but they are not persuasive.

With respect to applicant's arguments on page 8 that Miyazaki does not teach the new limitation.

In reply, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Kinjo teaches the user selecting the image data for printing and Miyazaki teaches taking user selections and cutting the printed product accordingly. Further, Miyazaki teaches conducting cutting operations at

Art Unit: 2625

predetermined locations on said sheet of media based on position location information of said user selections on said sheet of media (based on user selected patterns for printing and cutting [Fig. 5- 10, 16, 17], the cutter [Fig. 12, 40] cuts the image, step 228, based on user selected positions).

4. Applicant's arguments directed towards Matsumura and the combination including Matsumura are moot in view of the new rejection below.

Claim Objections

5. Claims 1 and 18 – 20 are objected to because of the following informalities: these claims include the phrase 'sheet of media located in said selected subject image file'. Examiner does not understand how a sheet of media is located in a computer image file. Examiner has not found any support in applicant's specification to support a file having a sheet of media in it. Examiner thus reads the claim to end after the word media for interpreting the claims. Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 2 – 4, 7 – 9, and 16 – 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kinjo (US 6519046) in view of Miyazaki et al. (US 6619166).

Regarding claim 1, Kinjo teaches the input of image placed in input image memory 17 (Fig. 1), processed in image processor 20, and output for printing on a digital printer 12 or at a remote location (through fax 13 or network connection). Further, in image processing steps, Kinjo teaches

a user identifying a subject within a digital image at a first location for producing a cut image product (user identifies a subject by tracing an outline on pad 51, example shown in Fig. 23, wherein the user selects the head of the individual for producing an image product including the head; col. 18 lines 63-67 and col. 19 lines 1-19 – col. 18 line 13 teaches cutting of the print product);

automatically differentiating the selected subject from the background of said digital image (image processing hardware and software then extracts the selected subject from the background as shown in Fig. 23B and 25B, wherein the extracted subject is shown as separate from the background; col. 19 line 31);

creating a selected subject image file of the selected subject (creating new ornamental pattern data that is stored; col. 19 lines 10-20, 32-40 and 50-60);

placing an order over a communication network, to a production facility at a second location that is remote from said first location for producing an image product using said selected subject image file (Fig. 5 shows the process of ordering prints and confirming the order over a communication network [that the data sending and receiving is performed over]; the photofinishing location being remote from the user do the need for delivery, wherein the

Art Unit: 2625

ornamental pattern data can be used in synthesized images for printing [see throughout, also col. 17 lines 57-59); and

printing an image of said selected subject on a sheet of media from said selected subject image file (printing shown in Fig. 5 wherein the photofinishing lab prints out the sent images, also 112 of Fig. 17 that uses the ornamental data table [including subject image files as discussed above] to synthesize with image data to form the composite output).

While Kinjo does teach cutting prints after printing (col. 18 line 13), Kinjo does not specifically teach cutting operations based on position location information of user selections.

However, Miyazaki teaches **conducting cutting operations at predetermined locations on said sheet of media based on position location information of said** user selections **on said sheet of media** (based on user selected patterns for printing and cutting [Fig. 5- 10, 16, 17], the cutter [Fig. 12, 40] cuts the image, step 228, based on user selected positions).

It would have been obvious to one of ordinary skill in the art to add the printing and cutting device of Miyazaki in the photofinishing lab of Kinjo. The motivation for doing so would have been to provide the user with many more options for output of images. The cutting pattern as cut in Miyazaki is selected by the user [col. 2 line 5] and can be cut in any arbitrary pattern [col. 14 lines 65-67] which makes it beneficial to print and cut the selected and extracted patterns of Kinjo. Further, the inventions of Miyazaki and Kinjo would be combinable because they are both developed by the same assignee [meaning there ability to be integrated with each other is implied] and they share some of the same photo editing and printing tasks and options [see Kinjo Fig. 33 and Miyazaki Fig. 22]. Further, the cutting of stickers and other types of memorabilia

discussed in Miyazaki that are made available by adding a cutter would be beneficial to Kinjo because the user has more options than just buying prints.

Regarding claim 2, which depends from claim 1, Kinjo further teaches that the **produced cut image product is delivered to a remote location** (wherein the product produced at the photofinisher is delivered to a remote location to the user to receive the prints; shown in the final steps of Fig. 5).

Regarding claim 3, which depends from claim 1, both Kinjo (Fig. 33) and Miyazaki (Fig. 22) teach having multiple image products on a single sheet of media. Further then, Miyazaki teaches that these multiple images are all cut according to their shapes (col. 3 lines 43-44)

Regarding claim 4, which depends from claim 1, Kinjo further teaches that a **computer software program is used to automatically differentiate said selected subject from said background** (it is implied that image processor 20 and image processing section 65 use computer software instructions to complete the differentiation of subject from background step as well as all other image processing steps including display for the user and adding text to images as discussed throughout Kinjo).

Regarding claim 7, which depends from claim 1, one of the advantages of adding the printing apparatus of Miyazaki to the system of Kinjo as discussed above is to give the user more printing options by adding the cutting. One of the options is to make sticker prints thus printing on a **sheet of media comprises an adhesive release layer and a image receiving layer having a printing side and a back side, said image receiving layer being positioned over said release layer, said back side having an adhesive layer thereon** (col. 14 lines 65-67 and col. 6 line 22).

Regarding claim 8, which depends from claim 7, Miyazaki further teaches that the **cut image product is made only on said printing layer** (col. 7 lines 1-3).

Regarding claim 9, which depends from claim 1, as discussed in the rejection of claim 7, Miyazaki teaches that the **sheet of media comprises a base layer** (bottom of sticker) **and an image receiving layer** (top of sticker) **having a printing side** (printed top of sticker) **and a back side** (adhesive bottom of sticker), **said image receiving layer being positioned over said base layer** (col. 14 lines 65-67 and col. 6 line 22).

Regarding claim 16, which depends from claim 1, Kinjo teaches that the **first location comprises a customer computer** (user data terminal 51 shown in Fig. 7 which is discussed as a customer computing device in col. 10 lines 31-42).

Regarding claim 17, which depends from claim 1, Miyazaki teaches the **first location comprises a kiosk at a retail location** (in Fig. 1, Miyazaki shows a computer kiosk that can be used at any location, including those that are commonly seen and known to those of ordinary skill in the art to be at retail locations).

Regarding claim 18, Kinjo teaches the input of image placed in input image memory 17 (Fig. 1), processed in image processor 20, and output for printing on a digital printer 12 or at a remote location (through fax 13 or network connection). Further, in image processing steps, Kinjo teaches

a user identifying a subject within a digital image at a first location for producing a cut image product using a computer (user identifies a subject by tracing an outline on pad 51, example shown in Fig. 23, wherein the user selects the head of the individual for producing an

Art Unit: 2625

image product including the head; col. 18 lines 63-67 and col. 19 lines 1-19 – col. 18 line 13 teaches cutting of the print product);

automatically differentiating the selected subject from the background of said digital image using a computer software (image processing hardware and software then extracts the selected subject from the background as shown in Fig. 23B and 25B, wherein the extracted subject is shown as separate from the background; col. 19 line 31);

creating a selected subject image file of the selected subject (creating new ornamental pattern data that is stored; col. 19 lines 10-20, 32-40 and 50-60);

placing an order over a communication network using said computer, to a production facility at a second location that is remote from said first location for producing an image product using said selected subject image file (Fig. 5 shows the process of ordering prints and confirming the order over a communication network [that the data sending and receiving is performed over]; the photofinishing location being remote from the user do the need for delivery, wherein the ornamental pattern data can be used in synthesized images for printing [see throughout, also col. 17 lines 57-59); **and**

printing an image of said selected subject on a sheet of media from said selected subject image file (printing shown in Fig. 5 wherein the photofinishing lab prints out the sent images, also 112 of Fig. 17 that uses the ornamental data table [including subject image files as discussed above] to synthesize with image data to form the composite output).

While Kinjo does teach cutting prints after printing (col. 18 line 13), Kinjo does not specifically teach cutting operations based on position location information of user selections.

However, Miyazaki teaches **conducting cutting operations at predetermined locations on said sheet of media based on position location information of said** user selections **on said sheet of media** (based on user selected patterns for printing and cutting [Fig. 5- 10, 16, 17], the cutter [Fig. 12, 40] cuts the image, step 228, based on user selected positions).

It would have been obvious to one of ordinary skill in the art to add the printing and cutting device of Miyazaki in the photofinishing lab of Kinjo. The motivation for doing so would have been to provide the user with many more options for output of images. The cutting pattern as cut in Miyazaki is selected by the user [col. 2 line 5] and can be cut in any arbitrary pattern [col. 14 lines 65-67] which makes it beneficial to print and cut the selected and extracted patterns of Kinjo. Further, the inventions of Miyazaki and Kinjo would be combinable because they are both developed by the same assignee [meaning there ability to be integrated with each other is implied] and they share some of the same photo editing and printing tasks and options [see Kinjo Fig. 33 and Miyazaki Fig. 22]. Further, the cutting of stickers and other types of memorabilia discussed in Miyazaki that are made available by adding a cutter would be beneficial to Kinjo because the user has more options than just buying prints.

Regarding claims 19 and 20, the method steps of claims 19 and 20 are the same as those of 1 and 18, respectively, except the wherein clause below. Therefore, claims 19 and 20 are rejected for the same reasons as set forth in the rejections of claims 1 and 18 above. Further, Miyazaki teaches **wherein a machine readable indicia is provided at the predetermined locations on the media that can be read by a cutting device that is used to produce said cut image product** (machine readable indicia 'M' that provides for the cutter to be at the

Art Unit: 2625

predetermined location for correct printing, the location based on the selection by the user; Figs. 15, 22, 23; col. 12 lines 27-50).

7. Claims 14 and 15 rejected under 35 U.S.C. 103(a) as being unpatentable over Kinjo and Miyazaki as applied to claim 1 above, and further in view of Fernandez et al. (US 2002/0092215).

Regarding claim 14, which depends from claim 1, while the combination teaches the user ordering prints with selected objects cut in them, the combination does not teach that the **cut image product comprises a free standing image having a stand section**.

Fernandez teaches a **cut image product that comprises a free standing image having a stand section** (Fig. 5, 5a, 5b paragraph [0034], wherein a contour cut image product is a free standing image having a stand section [flap 8]).

It would have been obvious to one of ordinary skill in the art to use the combination of Kinjo and Miyazaki to produce cut image products with stands as in Fernandez. The motivation for doing so would have been to provide customers with more options of printed matter. Customers like to customize and be creative with photographs, thus giving them options, such as custom magnets, mouse pads, stickers, labels, decals, and freestanding images would be advantageous to a photograph print retailer. Further, a standard method of displaying a printed image is to place it in a frame with a stand. The invention of Fernandez eliminates the need for an expensive frame in order to stand an image for viewing and Fernandez in paragraphs 001, 002, and 003 discuss the art that the invention would be best suited in, including photographic reproduction art that the combination of Kinjo and Miyazaki would be included in.

Regarding claim 15, which depends from claim 14, Fernandez includes that the **stand is integrally part of said cut image product** (Fig. 5 shows that the outputted product is all one piece [including the stand flap 8] and is merely folded and set in place for the final product in 5b).

8. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kinjo and Miyazaki as applied to claims 1 and 9 above, and further in view of Buck (US 5851614).

Regarding claim 12, which depends from claim 9, while the combination teaches the printing and cutting out of stickers with an adhesive base layer, the combination does not teach that the **base layer is a transparent base layer**.

Buck teaches a cut image product where the **base layer is a transparent base layer** (shown in Fig. 1; col. 3 lines 17-21).

It would have been obvious to one of ordinary skill in the art that one could use the combination of Kinjo and Miyazaki to print decals using a base transparent layer as taught in Buck. The motivation for doing so would have been to provide customers with more options of printed matter. Customers like to customize and be creative with photographs, thus giving them options, such as custom magnets, mouse pads, stickers, labels, decals, calendars, puzzles, and freestanding images would be advantageous to a photograph print retailer.

9. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kinjo and Miyazaki as applied to claims 1 and 9 above, and further in view of Peck (US 5899010).

Regarding claim 11, which depends from claim 9, while the combination teaches the printing and cutting out of stickers with an adhesive base layer, the combination does not teach that the **base layer comprises a static cling base layer**.

Peck teaches a cut image product where the **base layer comprises a static cling base layer** (Fig. 1 shows a cut image product which can be other images [col. 2 lines 45-59] on a static cling back layer).

It would have been obvious to one of ordinary skill in the art that one could use the combination of Kinjo and Miyazaki to print decals using a base static cling layer as taught in Peck. The motivation for doing so would have been to provide customers with more options of printed matter. Customers like to customize and be creative with photographs, thus giving them options, such as custom magnets, mouse pads, stickers, labels, decals, calendars, puzzles, and freestanding images would be advantageous to a photograph print retailer. Further, the static cling base layer would allow the cut image to be adhere to plastic without leaving the adhesive residue of stickers (Fig. 2 where the static cling decals adhere to plastic backing sheet 20).

10. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kinjo and Miyazaki as applied to claims 1 and 9 above, and further in view of Ogikubo (US 5994990).

Regarding claim 10, which depends from claim 9, while the combination teaches the printing and cutting out of stickers with an adhesive base layer, the combination does not teach that the **base layer comprises a static flexible magnetic layer**.

Ogikubo teaches magnetic sheet for printing images on where the **base layer comprises a flexible magnetic layer** (Fig. 1 shows the layers with 2 is the printing layer and base layer 3 is a flexible magnetic layer; col. 1 lines 5-12).

It would have been obvious to one of ordinary skill in the art that one could use the combination of Kinjo and Miyazaki to print magnets using a base magnetic layer as taught in Ogikubo. The motivation for doing so would have been to provide customers with more options

of printed matter. Customers like to customize and be creative with photographs, thus giving them options, such as custom magnets, mouse pads, stickers, labels, decals, calendars, puzzles, and freestanding images would be advantageous to a photograph print retailer.

11. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kinjo and Miyazaki as applied to claim 1 above, and further in view of Poole (US 5962368).

Regarding claim 13, which depends from claim 1, the combination of Kinjo and Miyazaki includes media of a base and image receiving layer as discussed in the rejection of claim 9 above. And while the combination teaches using a adhesive base layer, the combination does not teach using **heat shrink film and a heat shrink base layer**.

Poole teaches a **heat shrink film including a heat shrink base layer** (Fig. 1 shows heat shrink film including printed images; col. 4 lines 15-22).

It would have been obvious to one of ordinary skill in the art that one could use the combination of Kinjo and Miyazaki to print images on heat shrink films. Further, Poole instructs to use a standard printing process (such as that of Kinjo and Miyazaki) in col. 4 lines 16-18. The motivation for doing so would to put any type of printed material onto many types of objects including baseball bats, bowling balls, bottles, etc... (see col. 3 lines 25-34). This would provide customers with more options of printed matter and customers like to customize and be creative with photographs, thus giving them options, such as custom magnets, mouse pads, stickers, labels, decals, calendars, puzzles, and freestanding images would be advantageous to a photograph print retailer.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lucas Divine whose telephone number is 571-272-7432. The examiner can normally be reached on Monday - Friday, 7:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams can be reached on 571-272-7471. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



KING Y. POON
PRIMARY EXAMINER

Lucas Divine
Examiner
Art Unit 2625

ljd